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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **America Online, Inc.**

Serial No. 74/**724,879**

Michael A. Grow of **Arent, Fox, Kintner, Plotkin & Kahn** for
America Online, Inc.

David Stine, Trademark Examining Attorney, Law Office 103
(**Michael Szoke**, Managing Attorney).

Before **Seeherman, Hohein** and **Walters**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

America Online, Inc. has filed an application to
register the designation "AOL" as a trademark for "publications,
namely[,] books and pamphlets dealing with the subject of
computer services and computer networks."¹

Registration has been finally refused under Sections 1,
2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127,
on the basis that, as used by applicant (hereinafter sometimes

¹ Ser. No. 74/724,879, filed on September 5, 1995, which alleges dates
of first use of October 1989.

referred to as "AOL") in the specimens of record, the designation does not function as a trademark to identify and distinguish books and pamphlets dealing with the subject of computer services and computer networks, and that therefore substitute, properly verified specimens showing use of "AOL" as a trademark for such goods is required. On the same statutory basis, registration has also been finally refused on the ground that the designation "AOL" is "[part of] the title of a single creative work" and, "[a]s such, the proposed mark defines a distinct genus of goods and does not indicate the source of the goods."

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusals to register.

Applicant, notably without any evidentiary support, argues that:

AOL is a company offering a wide array of related goods and services, including the well known AOL computer network service. The AOL service provides not only access to the Internet and related products, but a host of proprietary information and documents that are only available to AOL subscribers. In addition, there have been various printed works sold that contain the mark AOL, such as the specimen submitted with the application. However, most of the publications made available to AOL subscribers would be requested and delivered electronically in connection with the AOL service. Because of the electronic nature of the service and the enormous and constantly changing content available to subscribers, it is virtually impossible to go back before the filing date of the present application and show through printed documentation how AOL was using its

mark AOL in connection with such electronic publications.

Today there are various books sold under the AOL mark. In addition to the AOL tour guide for [W]indows that was submitted as the specimen, there is an AOL tour guide for MAC users, an AOL tour guide for DOS, and an AOL tour guide for Windows 95. There also is an AOL Keywords publication, an AOL games guide and various other printed on paper publications.

In the minds of consumers, the famous mark AOL is identified as an indicator of the source of the paper publications as well as the electronic publications when that mark appears on such goods.

Applicant, in view thereof, further contends that in the phrase "The Official AOL for Windows Tour Guide," which is shown on the specimens next to what appears to be the page designation "viii" followed by what seems to be a portion of a table of contents, it is the designation "AOL" which "would be viewed by consumers to fulfill the source identifying function of a mark." Specifically, applicant maintains that:

The other words surrounding the mark AOL such as "the official" and "for Windows tour guide" ... [do] not create a situation in which the famous mark AOL ... [does] not function as a mark on its own for the publication. Indeed, the other words merely describe the nature of the goods, namely, that it is an official publication and that it is a tour guide for those using Windows software.

Applicant accordingly insists that the designation "AOL" forms "a separate and distinct commercial impression" apart from the other wording with which it is used and that, therefore, it functions as a trademark for applicant's publications and substitute specimens are not necessary. Moreover, as to the refusal that

the designation "AOL" is part of the title of a single creative work," applicant urges--again without any evidentiary support--that "[t]he mark is used on a variety of goods and services and is not a single title."

The Examining Attorney, on the other hand, asserts that (*italics and underlining in original*):

[Pursuant to Trademark Rule] 2.51, the mark in the drawing must be a substantially exact representation of the mark as actually used. This requirement has been interpreted to require that, if [an] applicant seeks to register only a single element of a composite mark used on the specimens, this single element must present an independent commercial impression, separate and distinct from the overall commercial impression created by the composite designation actually used on the specimens. See: *In re Chemical Dynamics Inc.*, 5 USPQ2d 1828 (Fed. Cir. 1988); *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989).

In the instant case, the mark presented for registration is the letter combination "AOL." The mark actually used, as indicated by the specimens[,] is "THE OFFICIAL AOL FOR WINDOWS TOUR GUIDE." Applicant has asserted, based on its overall context of use of the term "AOL" as a corporate trademark/-servicemark/housemark, that this designation does create a separate commercial impression, distinct from the overall designation "THE OFFICIAL AOL FOR WINDOWS TOUR GUIDE." This argument is considered specious. The actual evidence presented by the applicant as to overall usage of "AOL" relates entirely to computer software and network services. No evidence as to the use of "AOL" with respect to other publications was submitted.

It is the undersigned's position that, contrary to applicant's position, the most likely perception of the overall designation "THE OFFICIAL AOL FOR WINDOWS TOUR GUIDE," as applied to a publication, is that the publication is "THE OFFICIAL TOUR GUIDE" pertaining to applicant's "AOL FOR WINDOWS" computer network service. To the extent that

"AOL" creates any separate commercial impression, this impression, and the accompanying source identification, is deemed likely, based on the purchasing public's strong familiarity with "AOL" as a source of computer network services, to pertain solely to applicant's "AOL FOR WINDOWS" computer network service. With respect to the printed publication, however, prospective purchasers are deemed likely to assume that "TOURGUIDE" [sic] merely addresses "AOL FOR WINDOWS" as content or subject matter. They are not considered likely to further assume that the publication itself necessarily emanates from the applicant. In fact, given the wide availability of computer-related self-help publications, from a wide variety of sources, a conclusion that consumers will identify applicant as the source of the publications at issue is dubious, at best.

Since the only acceptable specimens of actual use submitted by applicant show only the unitary title "THE OFFICIAL AOL FOR WINDOWS TOUR GUIDE," and since the proposed mark "AOL" represents an integral portion of that title which does not create a separate and distinct overall commercial impression, the specimens are unacceptable as failing to indicate actual trademark use of the designation "AOL" on the goods identified in the application.

As to the other ground for refusal, the Examining Attorney argues that, "even if the designation 'AOL' is recognized as having a separate commercial impression, the proposed mark defines a distinct genus of goods and does not indicate the source of the goods" since it is part of the title of a single creative work. Citing *In re Cooper*, 254 F.2d 611, 117 USPQ 396 (CCPA 1958), *cert. denied*, 358 U.S. 840, 119 USPQ 501 (1958) and *In re Scholastic Inc.*, 223 USPQ 431 (TTAB 1984), the Examining Attorney notes that "[a]lthough applicant did provide some evidence of use of the designation 'AOL' in connection with electronic publications, none of the evidence

pertained to printed matter." In particular, the Examining Attorney observes that there is no evidence supporting applicant's contention that there are currently various printed books being sold under the mark "AOL".

As to the first basis for refusal, we agree with the Examining Attorney that, as used in the specimens, the designation "AOL" fails to project a separate and distinct commercial impression in relation to the other words with which it appears in the phrase "The Official AOL for Windows Tour Guide". Even assuming, as the Examining Attorney concedes, that the purchasing public for applicant's books and pamphlets dealing with the subject of computer services and computer networks has a "strong familiarity with 'AOL' as a source of computer network services," such familiarity does not necessarily extend to the use of "AOL" in connection with printed publications generally or even to printed books and pamphlets dealing with the subject of computer services and computer networks.

More significantly, however, we find that the words which appear with the designation "AOL" in the phrase "The Official AOL for Windows Tour Guide" to be suggestive rather than descriptive of applicant's goods and thus the purchasing public would not discount them and rely on the designation "AOL" alone as a source indicator. Furthermore, it is not even clear whether, as used on the specimens, the designation "AOL" or the phrase in which it appears would make any kind of commercial impression upon consumers or prospective buyers in that they would be exposed thereto when purchasing applicant's goods. The

specimens plainly are not the cover or title page of a book or pamphlet. Instead, the specimens appear to be the eighth page of a table of contents which bears the heading or title of "The Official AOL for Windows Tour Guide." Given the unitary nature of such caption, it is apparent that the designation "AOL" does not project a separate and distinct commercial impression from the overall phrase in which it is actually used and thus does not function as a trademark for applicant's goods. The refusal to register is therefore well taken and the requirement for substitute, properly verified specimens showing use of "AOL" as a trademark for applicant's books and pamphlets is proper.

Turning to the other basis for refusal, we concur with the Examining Attorney that, at best, the designation "AOL," as used in phrase "The Official AOL for Windows Tour Guide," would be regarded by the purchasing public as part of the title of a single work rather than as a source designator of a series of books and pamphlets. Compare In re Cooper, supra, and In re Scholastic Inc., supra, with In re Scholastic Inc., 23 USPQ2d 1774 (TTAB 1992). Applicant's *mere argument* that it *presently* is selling "various books ... under the AOL mark," such as "an AOL tour guide for MAC users, an AOL tour guide for DOS, and an AOL tour guide for Windows 95," as well as "an AOL Keywords publication, an AOL games guide and various other printed on paper publications," simply is *not evidence* that the designation "AOL" is actually used in such a manner that it functions as an indication of source for a series of books and pamphlets on the subject of computer services and computer networks. Absent such

Ser. No. 74/724,879

proof, the designation "AOL" is merely part of the title of a single publication and, accordingly, the refusal to register is well taken.

Decision: The refusals to register are affirmed.

E. J. Seeherman

G. D. Hohein

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board